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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 54084-62559	
I hereby certify that this correspondence has been electronically filed with the U.S. Patent and Trademark Office via the EFS Web on <u>October 14, 2008</u>		Application Number 10/586,018	Filed 7/14/2006
Signature <u>Joseph M. Rolnicki</u>		First Named Inventor Scheller et al.	
Typed or printed name <u>Joseph M. Rolnicki</u>		Art Unit 3739	Examiner Chen, Victoria W.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 32653
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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October 14, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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Joseph M. Rolnicki
Reg. No. 32,653

In re Application of: Scheller et al.	:	
	:	Examiner: Chen, Victoria W.
Serial No. 10/586,018	:	
	:	Group Art Unit: 3739
Filed: November 15, 2004	:	
	:	
For: SURGICAL INSTRUMENT	:	
HANDLE WITH ADJUSTABLE	:	
ACTUATOR POSITION	:	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

It is respectfully requested that the Final Rejection of claims 1-9, 12 and 13 of the above-referenced patent application made in the Office Action having a notification date of July 14, 2008, be reviewed. The rejection of the claims is based on clear errors in the interpretation of the disclosures of the prior art references relied on in the rejections of the claims, and on errors in the requirements for anticipation and obviousness rejections under the patent law.

Following the Final Rejection of the claims, an Amendment and Response B was filed in the application correcting what was considered to be indefinite language in claims 1, 2, 10, and 12.

Claims 1, 8 and 9 were rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Richards No. 5,634,918. Of these rejected claims, claims 1 and 8 are independent claims. Claim 9 depends from claim 8. It is respectfully submitted that the independent claims 1 and 8 recite elements of the invention that are not identically shown by the Richards reference, and therefore the Richards reference does not anticipate the subject matter of these claims under the patent law.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

In Re Bond, 910 F.2d 831, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates claims of anticipation.

Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 924 F. Supp. 1101, 39 USPQ 2d 1969, 1980 (D. Utah 1996), *aff'd in part, rev'd in part on other grounds*, 127 F.3d 1065, 44 USPQ 2d 1336 (Fed. Cir. 1997).

Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate.

Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc., 45 F.3d 1550, 33 USPQ 2d 1496, 1498, 1995-1 Trade Cas. (CCH) P 70891 (Fed. Cir. 1995).

Claim 1 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 mounted on the rod. The claim further describes the forward grip member 82 as having a plurality of resilient arms 102 that extend along the rod 14, and the plurality of arms having distal ends 92. In the anticipation rejection of claim 1, the rejection refers to Figure 5 of the Richards reference and interprets the rod 14' of Figure 5 as the rod of claim 1. The rejection interprets the Richards trigger retainer 22' of Figure 5 as the forward grip member of claim 1. The rejection also interprets the Richards pins 40' of Figure 5 as the resilient arms of claim 1. However, claim 1 recites "the forward grip member having a plurality of resilient arms that extend along the rod." In viewing Figure 5 of Richards, the pins 40' are separate component parts from the trigger retainer 22'. The trigger retainer 22', which is interpreted as the claimed forward

grip member, does not have a plurality of resilient arms as required by claim 1. Therefore, Figure 5 of the Richards reference does not identically show every element of the invention recited in claim 1, as is required for a proper anticipation rejection under the above-cited case law. Interpreting the language of claim 1 consistent with the specification, as is required by the above-cited case law, the Richards reference does not identically show every element of the claimed invention. The Richards reference therefore does not anticipate claim 1, and claim 1 is allowable over the prior art.

Furthermore, if the pins 40' of Richards are to be interpreted as the resilient arms 102 of claim 1, and if the pins 40' are to be interpreted as a part of the trigger retainer 22' and are to be interpreted as extending along the rod 14' as recited in claim 1, then the radial outer ends 400' of the pins 40' should be interpreted as the distal ends of the plurality of arms recited in claim 1. However, claim 1 requires that the distal ends 96 of the plurality of arms 102 operatively engage with the piston 16. In contrast, the radial outer ends 400' of the pins 40' are positioned radially outward from the piston 34'. Therefore, interpreting the Richards reference as is done in the Final Rejection of claim 1, the Richards reference also does not identically show "the forward grip member having a plurality of resilient arms that extend along the rod, the plurality of arms having distal ends that operatively engage with the piston." In view of this further difference between the subject matter of the invention recited in claim 1 and the disclosure of the Richards reference, the Richards reference does not identically show every element of the invention required for a proper anticipation rejection under the above-cited case law.

In the "Response to Arguments" portion of the Final Rejection it is argued that "there is no language in the claims which precludes the forward grip member and resilient arms being separate pieces of one component." However, the language of claim 1 has clearly set forth "the forward grip member having a plurality of resilient arms." The commonly understood meaning and dictionary definition of "having" is to possess or contain as a constituent part, or to hold, include, or contain as a part or whole. As used in the specification and claims, the forward grip member 82 is described as having a plurality of resilient arms 102. The Richards trigger retainer 22' does not have a plurality of resilient arms. The pins 40' are separate component parts

that are not a part of the trigger retainer 22'. The Richards reference does not identically show every feature of the claimed invention, and does not anticipate claim 1.

In the anticipation rejection of claim 8 in view of the Richards reference, the Richards piston 34F' is interpreted as the piston of claim 8, and the trigger retainer 22' of Richards is interpreted as the ring mounted on the rod of claim 8. However, claim 8 requires that the ring 18 engage with the piston 16. In viewing Figure 5 of the Richards reference, the trigger retainer 22' which is interpreted as the claimed ring 18 is spaced from the Richards piston 34F' by the pins 40' and never comes into engagement with the Richards piston 34F'. In view of this structural difference, the Richards reference fails to identically show every feature of the invention recited in independent claim 8, and therefore does not anticipate claim 8 under the above-cited case law.

Claim 9 depends from claim 8 and therefore is not anticipated by the Richards reference for the reasons discussed above.

Claims 3-7, 12 and 13 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the disclosure of the U.S. Patent of Richards No. 5,634,918. Of these rejected claims, claim 3 is the only independent claim. Claims 4-7, 12 and 13 all depend from independent claim 3. It is respectfully submitted that independent claim 3 recites structural features of the invention that are not disclosed or suggested by the Richards reference, and therefore the Richards reference does not make obvious the subject matter of these claims under patent law.

If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination.

Tec Air, Inc. v. Denso Mfg. Michigan, Inc., 192 F.3d 1353, 52 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999).

Independent claim 3 of the rejected claims recites "a plurality of resilient arms integrally connected with the forward grip member." In the rejection of the claims, it is contended that it would be obvious "to make the resilient arms integral with the forward grip member." However, making the pins 40' of the Richards reference, which are interpreted as the claimed resilient arms, an integral part with the trigger actuator 22' of the reference, which is interpreted as the claimed forward grip member, would render

the instrument of Richards inoperable. In use of the instrument in the Richards reference, the pins 40' move relative to the trigger actuator 22' when the triggers 20' are pivoted relative to the rod 14'. Therefore, the Richards pins 40' and the trigger actuator 22' could not be made as a single integral part as contended in the rejection of claim 3 without destroying the operability of the Richards instrument. Under the above cited case law, the subject matter of claim 3 is not made obvious by the Richards reference, and claim 3 and its dependent claims 4-7, 12, and 13 are all allowable over the prior art.

It is respectfully submitted that for the reasons set forth above, the Final Rejections of the claims are made in error and should be withdrawn and the claims allowed.

Respectfully submitted,

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